

### **REMARKS**

Claims 12, 13 and 30-32 are now present in the application. Claim 12 and 30-32 have been amended and claims 1-11 and 14-29 have been canceled by the present amendment or a previous amendment. Claims 30-32 stand withdrawn from consideration as being directed to a non-elected invention. Claims 12 and 32 are independent. Reconsideration of this application, as amended, is respectfully requested.

#### ***Reasons for Entry of Amendments***

It is respectfully requested that the present amendments be entered into the official file in view of the fact that the amendments to the claims automatically place the application into condition for allowance. In the alternative, if the Examiner does not believe that the application is in condition for allowance, it is respectfully requested that the amendments be entered for the purposes of Appeal. The amendments to the claims simplify the issues on appeal by further clarifying the independent claims over the references relied on by the Examiner.

#### ***Election/Restriction***

Claims 30-32 stand withdrawn from consideration by the Examiner as being directed to a non-elected invention. The Examiner indicates that claims 30 and 31 will be rejoined and allowed once claims 12 and 13 are found to be allowable. Applicants appreciate this indication from the

Examiner. In view of the below remarks, it is believed that claims 12 and 13 are in condition for allowance. Accordingly, claims 30 and 31 should also be in condition for allowance.

With regard to claim 32, this claim is directed to a cementitious board that includes a non-woven mat of glass fibers. It is believed that this claim is not independent and distinct from claim 12. Accordingly, this claim should be examined in the present application.

***Rejections Under 35 U.S.C. §§ 102 and 103***

Claims 12 and 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Cantwell, U.S. Patent No. 5,786,028. Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dickenson et al., U.S. Patent No. 5,409,768 in view of Caldwell et al., U.S. Patent No. 5,856,245, Amann, U.S. Patent No. 5,223,329 or Tashiro et al., U.S. Patent No. 5,204,041. These rejections are respectfully traversed.

The present invention is directed to a non-woven mat of glass fibers and a cementitious board having a sheet of a non-woven mat of glass fibers embedded therein. An embodiment of the present invention is exemplified by independent claim 12. Independent claim 12 recites a combination of elements including the recitation “wherein the substance weight/unit area of the at least one edge margin is generally uniform across an entire width of the at least one edge margin.” Furthermore, independent claim 12 recites that the substance weight/unit area varies in the cross direction of the mat and that the mat is “permeable to a gypsum plaster slurry.” Applicants respectfully submit that none of the references relied on by the Examiner teach these aspects of the present invention.

In particular, Cantwell is directed to a masking tape used in spray application or removal of coatings along a demarcation line. Referring to page 3 of the Examiner's Office Action dated March 14, 2003, the Examiner states "Cantwell teaches a non-woven fiberglass mat, wherein the edge margins of the fabric are cut at an angle such that they have a lower substance than the remainder of the mat (cols. 5-6, lines 54-2 and figs. 2 and 5)." Referring to Figure 2 of Cantwell, the edge margins of the fabric are clearly illustrated as having a varying thickness. In view of this, Cantwell fails to disclose that "the substance weight/unit area of the at least one edge margin is generally uniform across an entire width of the at least one edge margin" as recited in independent claim 12. In view of this, the Cantwell reference fails to anticipate independent claim 12 of the present invention.

The Examiner has also rejected claims 12 and 13 as being obvious over Dickenson et al. when taken in combination with Caldwell et al., Amann or Tashiro et al. Dickenson et al. discloses a multi-component nonwoven fibrous web. As the Examiner acknowledges, this reference teaches the use of organic fibers to manufacture the web, rather than inorganic fibers as previously recited in independent claim 12 of the present invention. The Examiner argues that in view of Caldwell et al., Amann and Tashiro et al., which all disclose the use of inorganic fibers, it would have been obvious to one having ordinary skill in the art to employ an inorganic fiber web in the multi-component non-woven fibrous structure of Dickenson et al., the motivation for doing so being the "desire to create a stronger fabric, which will not degrade when contacted with fluids" (see the Examiner's Office Action dated March 14, 2003).

However, in column 2, lines 40 to 47 of Dickenson et al., it is stated that the addition of reinforcing fibers throughout prior art wood pulp fluff absorbents to provide integrity limits "the ability to scarf the absorbent to contour or shave its exterior design." In column 2, lines 50 to 56, the process which is the subject of Dickenson et al. is said to overcome this problem by enabling the integrity fibers to be "strategically placed within localized regions of the material away from the scarfing roll, thereby providing sufficient integrity while also permitting scarfing to contour the exterior surface of the material." Contrary to the Examiner's assertion, based on the teaching of this document one having ordinary skill in the art would not have been motivated to utilize stronger inorganic fibers in the process of Dickenson et al. as he would not have expected to be able to shave the edges of the resulting inorganic fiber web. Accordingly, this document teaches away from the present invention.

In the Examiner's Office Action dated December 12, 2003, the Examiner argues that some inorganic fibers can be easily shaved and therefore modifying the Dickenson et al. web to include such fibers would be obvious. Specifically, referring to page 4, lines 3-6 of the Examiner's Office Action dated December 19, 2003, the Examiner states "[s]ome inorganic fibers, such as metal or glass, would cause difficulty in shaving, but many inorganic fibers could be easily shaved. Applicant's claims fail to specify what inorganic fibers are used."

Although Applicants do not completely agree with the Examiners position, in order to expedite prosecution, independent claim 12 has been amended to recite "glass" fiber. As admitted by the Examiner, inorganic fibers such as metal or glass would be difficult to shave. In view of this, Applicants submit that the modification proposed by the Examiner would not have been obvious to

one having ordinary skill in the art. As mentioned above, Dickenson et al. discloses that reinforcing fibers, such as glass fibers, limit the ability to scarf the web to shave the exterior design. In view of this, it would not be obvious to include glass fibers in the Dickenson et al. web.

With regard to dependent claim 13, Applicants respectfully submit that this claim is allowable due to its dependence on independent claim 12, as well as due to the additional recitations in this claim.

In view of the above amendments and remarks, Applicants respectfully submit that claims 12 and 13 clearly define the present invention over the references relied on by the Examiner. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102 and 103 are respectfully requested.

### **CONCLUSION**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn.


It is believed that a full and complete response has been made to the Office Action, and as such, the present application is in condition for allowance.

In the event there are any outstanding matters remaining in this application the Examiner is invited to contact Mr. Paul C. Lewis (Reg. No. 43,368) at (703) 205-8000 in the Washington, D.C. area to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

James M. Slattery, #28,380

*for* P.O. Box 747 *#43,368*  
Falls Church, VA 22040-0747  
(703) 205-8000

JMS/PCL/cl  
0014-0196P